

PATENT

Customer Number 22,852

Attorney Docket No. 1147-0142

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:
U.S. Patent No. 5,750,338

Mark L. Collins et al.

Reissue Serial No.: 09/533,906

Reissue Application Filed: March 8, 2000

For: TARGET AND BACKGROUND
CAPTURE METHODS WITH
AMPLIFICATION FOR AFFINITY
ASSAYS

Group Art Unit: 1655

Examiner: D. Johannsen

REISSUE LITIGATION BOX

Assistant Commissioner for Patents

Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

The Patent Owner brings to the attention of the Examiner the documents listed on the attached PTO 1449. This Information Disclosure Statement is being filed with the Patent Owner's Response to Gen-Probe's Protest.

Copies of the listed documents are being filed herewith as the Exhibits to the Patent Owner's Response to Gen-Probe's Protest.

The Patent Owner respectfully requests that the Examiner consider the listed documents and indicate that they were considered by making appropriate notations on the attached form.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that each or all of the listed documents are material or constitute "prior art." If the Examiner applies any of the documents as prior art against any claim in the application and the Patent Owner determines that the cited document(s) do not constitute "prior art" under United States law, the Patent Owner reserves the right to present to the office the relevant facts and law regarding the appropriate status of such documents.

The Patent Owner further reserves the right to take appropriate action to establish the patentability of the disclosed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: Jean Burke Fordis
Jean Burke Fordis
Reg. No. 32,984

Date: January 16, 2001

INFORMATION DISCLOSURE CITATION
(Use several sheets if necessary)

Atty. Docket No. 01147-0142-00000				Reissue Serial No. 09/533,906			
Applicant Mark L. Collins et al.							
Filing Date March 8, 2000				Group 1655			
U.S. PATENT DOCUMENTS							
Examiner Initial*		Document Number	Date	Name	Class	Sub Class	Filing Date If Appropriate
		4,683,202	7/28/87	Mullis			
		5,399,491	3/21/95	Kacian et al.			
		5,639,599	6/17/97	Ryder et al.			
		5,731,148	3/24/98	Becker et al.			
		6,025,133	2/15/00	Stull et al.			
		6,110,678	8/29/00	Weisburg et al.			
		6,130,038	10/10/00	Becker et al.			
FOREIGN PATENT DOCUMENTS							
		Document Number	Date	Country	Class	Sub Class	Translation Yes or No
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
	Gilles Mangiapan et al., <i>Sequence Capture-PCR Improves Detection of Mycobacterial DNA in Clinical Specimens</i> , Journal of Clinical Microbiology, 34:1209-1215 (1996).						
	Margareta Ieven et al., <i>Relevance of Nucleic Acid Amplification Techniques for Diagnosis of Respiratory Tract Infections in the Clinical Laboratory</i> , Clinical Microbiology Reviews, 10:242-256 (1997).						
	Axel Ullrich et al., <i>Rat Insulin Genes: Construction of Plasmids Containing the Coding Sequences</i> , Science, 196:1313-1319 (1977).						
	Russ Higuchi et al., <i>A General Method for Cloning Eukaryotic Structural Gene Sequences</i> , Proceedings of the National Academy of Sciences USA, 73:3146-3150 (1976).						
	Anthony J. Mazaitis et al., <i>Partial Isolation of an RII B Segment of T4 DNA by Hybridization with Homologous RNA</i> , Proceedings of the National Academy of Sciences USA, 57:1633-1637 (1967).						
	W. Stuart Riggsby, <i>A General Method of Fractionation of Nucleic Acids on the Basis of Sequence Homology</i> , Biochemistry, 8:222-230 (1969).						
Examiner				Date Considered			
*Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.							
Form PTO 1449				Patent and Trademark Office - U.S. Department of Commerce			

OMB No. 0651-0011

INFORMATION DISCLOSURE CITATION
(Use several sheets if necessary)

Atty. Docket No.	01147-0142-00000	Reissue Serial No.	09/533,906
Applicant	Mark L. Collins et al.		
Filing Date	March 8, 2000	Group	1655
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)			
	Amos Panet et al., <i>Studies on Polynucleotides: The Linkage of Deoxyribopolynucleotide Templates to Cellulose and Its Use in Their Replication</i> , The Journal of Biological Chemistry, 249:5213-5221 (1974).		
	Kary B. Mullis, <i>PCR and Scientific Invention: The Trial of DuPont vs. Cetus</i> , in THE POLYMERASE CHAIN REACTION (Kary B. Mullis et al. eds., Birkhauser Boston, 1994), pp. 428-441.		
	Paul Rabinow, <i>MAKING PCR: A STORY OF BIOTECHNOLOGY</i> (Univ. Chicago Press 1996), p. 9.		
	S.M. Tilghman et al., <i>Cloning Specific Segments of the Mammalian Genome: Bacteriophage λ Containing Mouse Globin and Surrounding Gene Sequences</i> , Proceedings of the National Academy of Sciences USA, 74:4406-4410 (1977).		
	Stuart H. Orkin et al., <i>Cloning and Direct Examination of a Structurally Abnormal Human β^0-thalassemia Globin Gene</i> , Proceedings of the National Academy of Sciences USA, 77:3558-3562 (June 1980).		
	Elizabeth Lacy et al., <i>Isolation and Characterization of Mammalian Globin Genes</i> , in CELLULAR AND MOLECULAR REGULATION OF HEMOGLOBIN SWITCHING, pp. 501-519 (1978).		
	A. P. Ryskov et al., <i>Short Communciation: Purification of Large Native DNA Fragments Enriched in Globin Gene Sequences</i> , Gene 3:81-85 (1978).		
	Craig Hill, <i>Automating Nucleic Acid Amplification Tests</i> , IVD Technology, 6:36-45 (November/December 2000).		
	PCR TECHNOLOGY (Henry A. Erlich, ed., Stockton Press 1989), pp. 1-5.		
	PCR PROTOCOLS, A GUIDE TO METHODS AND APPLICATIONS, (Michael A. Innis et al. eds., Academic Press 1990), pp. 13-19.		
	E. T. Wang of Painewebber, Inc., <i>Biotechnology Research Note</i> , The Investext Group, (OneSource Information Services, Inc. October 26, 2000).		
	C. Copithorne et al. of Morgan Stanley, Dean Witter, <i>Quarterly Income Statements</i> , The Investext Group, (OneSource Information Services, Inc. October 26, 2000).		
	Web pages for Gen-Probe, http://www.gen-probe.com/bottom.html .		
Examiner	Date Considered		
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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)			
	David J. Lane, Ph.D., <i>Declaration of David J. Lane, Ph.D. in Support of Motion of VYSIS, Inc. to Compel Gen-Probe, Incorporated to Produce Research and Development and Commercial Success Documents</i> , filed in United States District Court, Southern District of California, November 10, 2000.		
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